REMARKS/ARGUMENTS

The Final Office Action of June 4, 2003 has been fully considered. Reconsideration of the application is respectfully requested.

The Examiner, in withdrawing the § 112, second paragraph rejections notes "that Applicant has not indicated that the particles 'are separated from the resulting sonicated stream' as described in the specification at page 8, lines 5-10." Applicants assert the open-ended "comprising" language of the claims allows the particles to be separated in the resulting particle stream as well as separated from the resulting particle stream.

The Examiner has rejected claims 1, 4-7, 10, 12, 16-20, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki (U.S. Pat. No. 5,576,075) in view of Hochberg (U.S. Pat. No. 3,890,240). Applicants respectfully traverse these rejections.

The Examiner states that Kawasaki "teaches a method and apparatus for sonicating, filtering, and coating." The Examiner further states that Hochberg "teaches a process for providing liquid dispersions of toner materials to be applied to a surface". The Examiner states that, though the two references do not provide all of the features of the present invention, it "would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kawasaki to provide the missing features". The Examiner lists, on pages 5-7, 6 allegedly obvious modifications. Applicants respectfully reassert this is an impermissible "obvious to try" analysis. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). There is no motivation, either explicit or implicit, within Kawasaki or Hochberg that would lead one of ordinary skill in the art, upon reading and understanding the references, to modify and vary these parameters. The Examiner states that it would have been obvious to modify Kawasaki and Hochberg by (1) sonicating the initial dispersion, (2) providing analysis stream pressure before filtering, (3) analysis of the sonicated stream for undesirable particles, (4) sonicating toner particles, (5) providing resin with the particles, and (6) coating a photoreceptor substrate. Applicants respectfully reassert that it could only be through the use of impermissible hindsight that the

Examiner could reach a conclusion of obviousness based on six modifications. Even if the Examiner is correct in his contention that these six modifications of Kawasaki and Hochberg would result in the present invention, it is unreasonable to believe that a combination of two disparate references plus six modifications could be "obvious".

Moreover, Applicants assert that the optimization of 6 parameters, each relative to the other, could only be achieved through undue experimentation. Applicants respectfully assert optimization of parameters, which can be achieved only through such undue experimentation, cannot be obvious. The Examiner has stated that no "obvious to try to modify" statement was made in the rejections. While the Examiner did not explicitly use the "obvious-to-try" language, the suggested modifications are certainly "obvious to try" modifications, due to the fact that the individual optimization of each suggestion is not obvious. Applicants therefore submit claims 1, 4-7, 10, 12, 16-20, and 27 are not obvious over Kawasaki in view of Hochberg. Withdrawal of the 35 U.S.C. § 103(a) rejections is respectfully requested.

Claims 8-9 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki in view of Hochberg as applied to claims 1, 4-7, 10, 12, 16-20, and 27, and further in view of EP 472 459 A1 ('459). Applicants respectfully traverse.

The Examiner states that Kawasaki and Hochberg teach all of the features of claims 8-9 and 15 except using a second sonicator to sonicate the filter and the filter purpose. Applicants respectfully reassert that the '459 patent is not analogous art. The Examiner states that it has been held that a prior art reference must either be in the field of the applicant's endeavor, or, if not, then reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Applicants assert it has also been held that to be analogous art, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). The '459 reference would not have logically commended itself to the inventor's attention in considering his problem. The Examiner contends that it is "concerned with providing unagglomerized particles in a

stream using an ultrasonic treatment and providing a filtration at the end of the stream." Applicants respectfully assert that the problems associated with treating spent nuclear reactor fuel elements are not reasonably related to the problems in the imaging arts. For this reason, an inventor would not logically look to the '459 reference for guidance in solving problems faced in the imaging arts. A person of ordinary skill in the imaging arts would have no motivation to consider radioactive fuel reclamation art in solving problems in the imaging arts. This is especially true in view of the toxicity issues driving radioactive fuel reclamation that do not drive the present invention. Applicants respectfully submit that the '459 reference is not analogous art and request withdrawal of the 35 U.S.C. § 103(a) rejections.

The Examiner has rejected claims 21, 23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki in view of '459. Applicants traverse.

The Examiner states that Kawasaki teaches all of the features of claims 21, 23, and 25-26 except for the treatment using a second sonicator to sonciate the filter as taught by '459. Applicants respectfully assert the teachings of the '459 patent, whether or not they teach the treatment of the present invention (Applicants maintain they do not), are moot. As discussed above, the '459 reference is non-analogous art. There is, therefore, no motivation for combining the reference that relates to the homogenizing and conveyance of a mixture of radioactive fuel residue with a reference for a composition and method for the production of magnetic recording medium to arrive at the present invention. The combination of references is, therefore, not obvious, and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections.

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawasaki in view of Hochberg as applied to claims 1, 4-7, 10, 12, 16-20, and 27, and further in view of Min. Applicants respectfully traverse.

According to the Examiner, Kawasaki in view of Hochberg teaches all the features of claim 11 except the gas carrier vehicle. The Examiner states, "Min teaches a process for sonicating a stream containing a dispersion of agglomerated primary particles,...[and] the stream includes a gas carrier, air." Applicants assert the Examiner's position is moot because Min is non-analogous art. *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992). The disclosure of Min would not be "logically

commended" to an inventor in the imaging arts field. Min is directed to an apparatus in the paper arts. One of ordinary skill in the imaging arts would have no motivation to turn to the paper arts to solve problems in the field of imaging arts. Moreover, there is no motivation in any of the three cited references that would lead one of ordinary skill in the imaging arts to combine a reference relating to magnetic recording media with a reference from the paper arts. Because Min is non-analogous art, Applicants respectfully assert claim 11 is not obvious over Kawasaki in view of Hochberg and further in view of Min. Withdrawal of the 35 U.S.C. § 103(a) rejections is respectfully requested.

Applicants respectfully assert the above remarks remove the Examiner's rejections of claims 1, 4-12, 15-21, 23, and 25-27. Withdrawal of the rejections and issuance of a Notice of Allowance is respectfully requested.

It is believed that no fee is due in conjunction with the present response. If, however, it is determined that a fee is due, authorization is given for deduction of that fee from Deposit Account No. 24-0037.

Respectfully submitted,

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